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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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**HEWLETT-PACKARD COMPANY**  
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EXAMINER
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VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/932,237

Applicant(s)

PHILLIPS ET AL.

Examiner

John Van Bramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on September 28, 2006 cancelled no claims. Claims 3, 4, 8, 18, and 19 were amended and new claims 21-25 were added. Thus the currently pending claims in the application are Claims 1-25. Additionally, the amendment to the specification received on September 28, 2006 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1- 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimbori et al. (U.S. Patent Application Publication: US 2004/0204986).

Claim 1: Shimbori discloses an article of manufacture comprising:

- a. A processor-usable medium having processor-useable code embodied therein and configured to cause processing circuitry to perform steps comprising:

- i. Providing a marketing message intended for an image forming device user from a party other than a provider of a consumable. (Page 2, Paragraph [0041])
- ii. Monitoring an association of a consumable with an image forming device. (Page 2, Paragraph [0044])
- iii. Enabling communication of the marketing message to the image forming device user responsive to the monitoring. (Page 2, Paragraph [0042])

Claim 2: Shimbori discloses the article of claim 1 wherein the monitoring comprises monitoring coupling of the consumable and the image-forming device. (Page 2, Paragraph [0044])

Claim 3: Shimbori discloses the article of claim 1 wherein the enabling comprises accessing the marketing message from a memory device of the consumable. (Page 2, Paragraph [0042])

Claim 4: Shimbori discloses the article of claim 1 wherein the enabling comprises accessing an identifier of the marketing message from a memory device of the consumable. (Page 2, Paragraph [0043])

Claim 5: Shimbori discloses the article of claim 1 wherein the enabling comprises communicating the marketing message to the image-forming device. (Page 3,

Paragraph [0049])

Claim 6: Shimbori discloses the article of claim 1 wherein the providing comprises providing the marketing message comprising a message unrelated to the consumable and unrelated to the image forming device. (Page 4, Paragraph [0070])

Claim 7: Shimbori discloses the article of claim 1 wherein the code is further configured to cause the processing circuitry to perform the step including offering the marketing message to parties other than providers of the consumable and the providing is responsive to the offering. (Page 2, Paragraph [0042]) and Page 6, Paragraph [0082])

Claim 8: Shimbori discloses a marketing method to image forming device users comprising:

- a. Providing a consumable usable in an image forming device to form hard images and usable to enable a marketing function with respect to image forming device users. (Page 2, Paragraph [0040])
- b. Making available the marketing function to other parties apart from a provider of the consumables. (Page 2, Paragraph [0041] through Paragraph [0042])
- c. Receiving an indication regarding a desirous party to utilize the marketing function. (Page 2, Paragraph [0041])

d. Enabling the marketing function for the desirous party using the consumable.

(Page 2, Paragraph [0041])

e. Initiating the marketing function after the enabling. (Page 2, Paragraph [0042])

Claim 9: Shimbori discloses the method of claim 8 wherein the initiating the marketing function comprises communicating a marketing message for the desirous party using the image-forming device. (Page 2, Paragraph [0042])

Claim 10: Shimbori discloses the method of claim 9 wherein the communicating comprises communicating the marketing message comprising a message unrelated to the consumable and unrelated to the image forming device. (Page 4, Paragraph [0070])

Claim 11: Shimbori discloses the method of claim 8 wherein the initiating comprises communicating a marketing message using an image-forming device. (Page 2, Paragraph [0042])

Claim 12: Shimbori discloses the method of claim 8 further comprising detecting a triggering event with respect to the consumables and wherein the initiating is responsive to the detecting. (Page 2, Paragraph [0044])

Claim 13: Shimbori discloses the method of claim 12 wherein the initiating

comprises communicating a marketing message. (Page 6, Paragraph [0082])

Claim 14: Shimbori discloses the method of claim 12 wherein the detecting the triggering event comprises detecting coupling of the consumable with an image-forming device. (Page 2, Paragraph [0044])

Claim 15: Shimbori discloses the method of claim 12 wherein the detecting the triggering event comprises detecting a condition of the consumable reaching a predetermined level. (Page 5, Paragraphs [0080] through [0081])

Claim 16: Shimbori discloses the method of claim 8 wherein the

- a. Providing the consumable comprises providing the consumable configured to enable the marketing function comprising communication of a marketing message associated with the desirous party. (Page 2, Paragraph [0040])
- b. The consumable comprises memory device configured to store the marketing message. (Page 1, Paragraphs [0015] through [0016])
- c. The enabling comprises storing the marketing message using the memory device. (Page 2, Paragraph [0042])
- d. The initiating comprises accessing the marketing message from the memory device and communicating the marketing message using the image-forming device after the accessing. (Page 2, Paragraph [0042])

Claim 17: Shimbori discloses the method of claim 8 wherein

- a. The consumable comprises a memory device. (Page 5, Paragraph [0075]) (The terms consumable and memory device are very broad. Even the paper, described in the cited paragraph can represent a consumable that is a memory device, since people use paper to print or write notes that aid in the memory of various items. Additionally, the printer itself is a consumable with a memory device because it has a useful life that will eventually be consumed.)
- b. The enabling comprises storing an identifier within the memory device to identify the marketing function for the desirous party. (Page 5, Paragraph [0075])
- c. The initiating comprises accessing the identifier. (Page 5, Paragraph [0075])
- d. Associating the consumable with an image-forming device. (Page 5, Paragraph [0075])
- e. First communicating the identifier externally of the image-forming device to identify the marketing function comprising a marketing message for the desirous party after the associating. (Page 5, Paragraph [0075])
- f. Receiving a marketing message within the image-forming device responsive to the first communicating. (Page 5, Paragraph [0075])
- g. Second communicating the marketing message using the image-forming device. (Page 5, Paragraph [0075])

Claim 18: Shimbori discloses the method of claim 8 wherein the enabling comprises



- a. Monitoring the consumable utilizing an external device with respect to the image forming device. (Page 5, Paragraph [0079])
- b. Detecting a status of the consumable reaching a predetermined status. (Page 5, Paragraph [0080])
- c. Wherein the initiating the marketing function comprises forwarding a marketing message to the image-forming device utilizing the external device responsive to the detecting status. (Page 2, Paragraph [0041])
- d. Communicating the marketing message using the image-forming device responsive to the detecting status. (Page 2, Paragraph [0042])

Claim 19: Shimbori discloses the method of claim 8 wherein the making available comprises offering electrical storage space of a memory device of a consumable to the other parties. (Page 4, Paragraph [0070])

Claim 20: Shimbori discloses a marketing method to printer users comprising:

- a. Providing a consumable usable in a printer to print hard images and usable to enable communication of a marketing message with respect to printer users. (Page 2, Paragraph [0040])
- b. Offering the contents of the marketing message to other parties apart from a provider of the consumables. (Page 2, Paragraph [0041])
- c. Receiving an indication regarding a desirous party to utilize the marketing message. (Page 2, Paragraph [0041])

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- d. Enabling a marketing message for the desirous party using the consumable and wherein the marketing message is unrelated to the printer and unrelated to the consumable. (Page 2, Paragraph [0042] and Page 4, Paragraph [0070])
- e. Detecting a triggering event with respect to the consumable after the associating. (Page 4, Paragraph [0070], [0073] and Page 5, Paragraph [0075])
- f. Initiating communication of the marketing message using the printer responsive to the detecting. (Page 4, Paragraph [0070], [0073] and Page 5, Paragraph [0075])

Claim 21: Shimbori discloses the article of claim 1 wherein the enabling comprises enabling responsive to the monitoring detecting the association comprising installation of the consumable within the image forming device. (Page 5, Paragraph [0075]) (Detection of the paper is performed and printing is enabled)

Claim 22: Shimbori discloses the method of claim 8 wherein the enabling comprises storing electrical data related to the marketing function using an electrical memory device of the consumable. (Page 4, Paragraph [0070])

Claim 23: Shimbori discloses the method of claim 8, wherein the enabling the marketing function comprises storing a marketing message in the form of electrical data using an electrical memory device of the consumable. (Page 4, Paragraph [0070])

Claim 24: Shimbori discloses the method of claim 17 wherein the enabling comprises storing electrical data of the identifier within the memory device comprising an electrical memory device configured to store the electrical data. (Page 4, Paragraph [0070] and Page 5, Paragraph [0075])

Claim 25: Shimbori discloses the method of claim 20 wherein the initiating communication comprises initiating printing of the marketing message using the printer. (Page 4, Paragraph [0070], [0073] and Page 5, Paragraph [0075])

### ***Response to Arguments***

4. Applicant's arguments filed September 28, 2006 have been fully considered but they are not persuasive.
  - a. Referring to Claim 1, the applicants argue that the Shimbori teachings are not arranged as defined in the claim. The applicants arguments are directed to the suggestion that Shimbori does not teach "monitoring an association of a consumable with an image forming device and enabling communication of the marketing message to the image forming device user responsive to the monitoring": However, the applicant implies an ordered interaction which is different from the order described in the claim. Claim 1 clearly describes providing a marketing message, which is clearly described as the advertisement in paragraph [0041] of Shimbori. The

claim further describes monitoring the association of a consumable with an image-forming device. This is clearly described in paragraphs [0044] and [0047] of Shimbori, where it teaches checking the remaining amount of consumables. Finally, Claim 1 recites enabling communication of the marketing message to the "image forming device user responsive to the monitoring". It is clear that the user of the image forming device is responsible for being responsive to the monitoring. The teachings of Shimbori disclose the claimed "enabling of communication to the user" in the previously cited paragraph {0042}. Proof that the user receiving the marketing message is responsive to the monitoring can be found in paragraph [0075] where the user is notified and must exchange the paper. Therefore, the teachings of Shimbori are arranged as defined in the claim. If the applicant intends to claim enabling communication in response to the monitoring the examiner suggests amending the claim to clearly describe such an interaction.

- b. Referring to claims 2 and 14, the applicant argues that paragraph [0044] of Shimbori fails to teach or suggest the monitoring of a coupling of the consumable and the image forming device. However, monitoring said coupling is inherent in paragraph [0044] since the disclosed checking can only be performed on those consumable that have been coupled to the disclosed device. Additional support for the monitoring of such coupling can be found in paragraph [0075] where an optical sensor is used to

monitor the coupling of the paper and the printer. Furthermore, the applicant's Claims 2 does not recite "monitoring of a coupling of the consumable and the image forming device" but rather recites "monitoring coupling of the consumable and the image forming device".

- c. Referring to claims 8 and 14, the applicant argues that Shimbori does not teach providing a consumable usable to enable a marketing function with respect to image forming device users in paragraph [0040]. However, paragraph [0040] of Shimbori specifically describes a system for printing an advertisement for a user on a consumable. Furthermore, paragraphs [0041] and [0042] also describe this limitation. Additionally, the applicant argues that Shimbori does not teach receiving an indication regarding a desirous party to utilize the marketing function. However, in the cited paragraph [0041] a advertiser desiring to send an advertisement to the user is recited. Finally, the applicant argues that Shimbori does not disclose enabling the marketing function using the consumable, but paragraph [0041] specifically discloses that the advertisements are printed on a consumable (paper), using a consumable (ink). The printing of the advertisement has enabled the marketing function to be displayed to the user.
- d. Referring to claim 16, the applicant argues that Shimbori does not teach a consumable containing a memory device. However, Claim 8 from which Claim 16 depends is a method or marketing to users of image forming

devices. Given the broad nature of the claim there are numerous interpretations of the language used within the claim. The image forming device could be a computer, the consumable could be a printer. Additionally, the image-forming device could be a printer and the consumable could be a piece of paper, or ink. The examiner has cited paragraphs within Shimbori which supports either of these interpretations.

- e. Referring to claim 17, the examiner has utilized the applicant's own specification, for example paragraph 22 which states that "the consumables are used to form hard images and include media, marking agents, components having fixed life spans and other expendable items to develop the rejection. As stated previously, using this definition, the image-forming device could be a computer, the consumable could be a printer. Additionally, the image-forming device could be a printer and the consumable could be a piece of paper, or ink. The Shimbori reference teaches the claimed interaction regardless of which interpretation is used. Finally, both of the interpretations are consistent with the claimed receiving the marketing message within the image forming device responsive to the first communicating and second communicating the marketing message using the image forming device. In order for the message to be printed on the paper it is inherent that it was received by the computer and communicated to the printer. It is also inherent that the

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printer received the information and placed in on the paper on which the image was formed.

- f. Referring to claim 20, the applicant argues that Shimbori does not teach detecting a triggering even and initiating communication of the marketing message using the printer responsive to the detecting. However, paragraph [0073] describes a detecting event with the printer and allowing the communication of the marketing method to continue or to be interrupted. Additionally, the detecting of additional triggering events and initiating of communication can be found in paragraphs [0070] and [0075].

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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